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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,702	10/05/2001	Hajime Takei	018656-252	1791

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EXAMINER
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MURPHY, DILLON J

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/970,702

Applicant(s)

TAKEI ET AL.

Examiner

Dillon J. Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- This action is responsive to the amendment filed January 17, 2007.
- Claims 1-15 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell (US 6,873,426) in view of Trovinger et al. (US 6,708,967).

Regarding claim 1, Farrell teaches a printing system (Farrell, fig 1, printing system #10) comprising an on-line client (Farrell, col 3, ln 45-49, wherein input section may be a networked personal computer), print server and printer (Farrell, fig 2, wherein controller #14 reads on a server and printer #16 is a printer), wherein the print server includes:

First memory means for storing specifications of the printer and of the finishing device as well as information regarding options installed thereon (Farrell, fig 2, system control #24 in controller #14, wherein system control is a processor, which inherently comprises a memory, col 5, ln 44-49. See col 4, ln 13-24, wherein specifications of printer and of the finishing device are stored. See col 4, ln 52-55 and col 5, ln 23-38,

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wherein machine-readable finishing specifics to be later applied are generated by system control #24, which teaches specification of the finishing device as well as information regarding installed thereon is stored in memory means);

Receiving means for receiving from the client data pertaining to a job ticket that includes at least finishing specifics for printing to be executed (Farrell, col 3, ln 55- col 4, ln 8, wherein a job ticket is received from a network personal computer, for example, which pertains to as least finishing specifics to be executed);

Sorting means for, based on the information regarding the specifications and installed options that is stored in the first memory means, separating the finishing specifics included in the job ticket received by the receiving means into those to be performed by the printer and those to be performed by the finishing device (Farrell, fig 2, printer #16 comprises print module #34 and finisher #18. See col 4, ln 13-24, for example, wherein finishing specifics are sorted into those to be performed at finisher #18 and those to be performed later at an off-line finishing device. Also see col 4 ln 43- col 5, ln 8, wherein finishing instructions may be performed, based upon the information regarding the specifications, by either the installed finishing element #18 or later by a separate finishing device).

Setting means for setting, in the printer, the parameters for the finishing specifics as separated by the sorting means and assigned to the printer (Farrell, col 5, ln 16-22, wherein finishing specifics are set in printer); and

Creating means for creating data for a finishing device job ticket that includes the finishing specifics separated by the sorting means and assigned to the finishing device

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(Farrell, col 5, ln 23-38, wherein a marker, which reads on a finishing device job ticket, includes sorted finishing specifics).

Although Farrell alludes to an off-line finishing device in col 4, ln 52-55 and col 5, ln 23-38, Farrell does not disclose expressly a printing system further comprising an off-line finishing device. However, Trovinger teaches a finishing device may be offline, receiving both papers and a job ticket from another device (Trovinger, col 3, ln 25-45, col 3, ln 55-63, and col 7, ln 45-55).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the off-line finishing device of Trovinger with the print system of Farrell comprising an online client, a server, and a printer, wherein the server comprises first memory means, receiving means, sorting means, setting means, and creating means. The suggestion for doing so was given by Farrell in col 4, ln 52-55 and col 5, ln 23-38 teaching a finishing device and finishing device job ticket in addition to the finishing device installed in the printer. The motivation for doing so would have been also to provide an easy transition from on-line to off-line finishing (Farrell, col 3, ln 16-17). Therefore, it would have been obvious to combine Trovinger with Farrell to obtain the invention as specified in claim 1.

Regarding claim 2, the combination of Farrell and Trovinger teaches a print system wherein the print server further includes transmitting means for transmitting to the printer the data pertaining to the finishing device job ticket created by the creating means so as to print the finishing device job ticket (Farrell, col 5, ln 30-38, wherein system controller #24 generates data to be printed as markers as machine-readable

and/or human readable description of the desired finishing operations on oversized media or media with job content).

Claim 4 recites identical features as claim 1 except claim 4 is an apparatus claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 4. Additionally see Farrell, fig 2, wherein controller #14 and system control #24 provide server functions, and col 4, ln 1-7, wherein the functions may be embedded in a single machine or as an integrated multifunction system.

Claim 5 recites identical features as claim 2 except claim 5 is an apparatus claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 5.

Claim 7 recites identical features as claim 1 except claim 7 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 7 because without a computer readable medium to store a program that makes it possible for the apparatus to operate, the apparatus taught by Farrell and cited the rejection for claim 1 could not function. Additionally see Farrell, col 5, ln 44-49, wherein the system controller #24 is a processor, and col 3, ln 65-67, wherein an input may be a computer over a network.

Claim 8 recites identical features as claim 2 except claim 8 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 8.

Claim 10 recites similar features as claim 1 except claim 10 is broader in the scope of the claim. Claim 10 is encompassed by claim 1. Thus, arguments similar to

that presented above for claim 1 are equally applicable to claim 10. A memory and processor are inherent to the operation of the system as taught by Farrell and Trovinger.

Claim 11 recites similar features as claim 2 except claim 11 is broader in the scope of the claim. Claim 11 is encompassed by claim 2. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 11.

Claim 13 recites similar features as claim 1 except claim 13 is broader in the scope of the claim. Claim 13 is encompassed by claim 1. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 13. A memory and processor are inherent to the operation of the system as taught by Farrell and Trovinger.

Claim 14 recites similar features as claim 2 except claim 14 is broader in the scope of the claim. Claim 14 is encompassed by claim 2. Thus, arguments similar to that presented above for claim 2 are equally applicable to claim 14.

Claims 3, 6, 9, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell (US 6,873,426) in view of Trovinger et al. (US 6,708,967) and further in view of Jeyachandran et al. (US 6,567,176).

Regarding claim 3, which depends from claim 2, the combination of Farrell and Trovinger teaches a printing system comprising a server that comprises memory means, receiving means, sorting means, setting means, creating means, and transmitting means. Furthermore, the combination additionally teaches second memory

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means for storing job information and user information included in the job ticket received by the receiving means (Farrell, fig 2, wherein disk (unnumbered) and image input control #22 provide second means for storing job information and user information included in job ticket, col 3, ln 55- col 4, ln 7. User preferences, for example, read on user information. Additionally, user information is well-known if not inherent to interact with a user (col 5, ln 2-3) as well as return a print job to a user); and reading means for reading the job information from the data obtained by reading via the scanner the finishing device job ticket printed by the printer (Trovinger, col 7, ln 45-55, wherein edge sensors read bar code indicia that are printed on a job ticket. Also see col 5, ln 23-58, wherein barcode indicia may be printed by the system of Farrell as a finishing job ticket for an off-line finishing device).

The combination of Farrell and Trovinger does not disclose expressly a system further comprising notifying means for calling the user information stored in the second memory means based on the job information read by the reading means and notifying the client of job completion based on the user information. Jeyachandran, however, teaches a printing system with notifying means for calling the user information stored in the second memory means based on the job information read by the reading means and notifying the client of job completion based on the user information (Jeyachandran, scanner reads in job and job information, transmits data to printer to be printed, and once printing is completed, notifies user that instructed job was performed based on information stored in memory, column 21, lines 7-15 and column 20, lines 46-52).



At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the notifying means of Jeyachandran with the printing system of Farrell and Trovinger comprising a server that comprises memory means, receiving means, sorting means, setting means, creating means, transmitting means, a second memory, and reading means. The motivation for doing so would have been to alert the user when the print job is done, thereby freeing the user from having to check for a completed print job when there may be not there. Therefore, it would have been obvious to combine Jeyachandran with the combination of Farrell and Trovinger to obtain the invention as specified in claim 3.

Claim 6 recites identical features as claim 3 except claim 6 is an apparatus claim. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 6.

Claim 9 recites identical features as claim 3 except claim 9 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 9.

Claim 12 recites similar features as claim 3 except claim 12 is broader in the scope of the claim. Claim 12 is encompassed by claim 3. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 12.

Claim 15 recites similar features as claim 3 except claim 15 is broader in the scope of the claim. Claim 15 is encompassed by claim 3. Thus, arguments similar to that presented above for claim 3 are equally applicable to claim 15.

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***Response to Arguments***

Applicant's arguments, see Remarks, filed January 17, 2007, with respect to the rejection(s) of claim(s) 1-15 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Farrell (US 6,873,426) in view of Trovinger et al. (US 6,708,967).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon J. Murphy whose telephone number is (571) 272-5945. The examiner can normally be reached on M-F, 8-5.

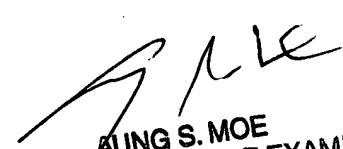
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571) 272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dillon Murphy  
March 20, 2007



AUNG S. MOE  
SUPERVISORY PATENT EXAMINER  
3/20/07